

## **REMARKS**

Claims 1-34 are pending in the present reissue application. This application is a reissue application of the U.S. Patent No. 5,916,127 ("the '127 Patent"). The '127 patent was issued from the application 08/688,622 ("the '622 Application").

This Amendment is in response to the Office Action mailed July 8, 2002. In the Office Action, the Examiner rejected claims 1, 4-5, 7, 9, 12, and 20-27 under 25 U.S.C. §251; claims 20 and 21 under 25 U.S.C. §112; and claims 1, 4-5, 7, 9, 12, 20, 21, and 25-27 under 35 U.S.C. §102(b). Applicant has amended claims 1, 5-7, 16-18, 26-28 and added new claim 35. Applicant submits that the newly added claim introduces no new matter. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

### **I. PRELIMINARY AMENDMENT**

In the Office Action, the Examiner stated that the preliminary amendment filed with this reissue application is not in full compliance with 37 CFR §1.173. Specifically, claims 1 and 11 include instances of language differing from that in the '127 Patent but not underlined and/or bracketed. In response, Applicant is concurrently re-submitting a Supplemental Preliminary Amendment with the corrections on claims 1 and 11.

### **II. RESTRICTION REQUIREMENT**

In the Office Action, the Examiner contends that Applicant claims two distinct inventions; namely, Group I (claims 1-28), drawn to a jet engine, classified in Class 60, subclass 226.1, and Group II (claims 29-34), drawn to a method of operating a jet engine, classified in Class 60, subclass 204. Thus, pursuant to 35 U.S.C. §121, the Examiner requires Applicant to restrict the application to one of the alleged two inventions.

Applicant respectfully traverses the restriction requirements for the following reasons. The species in set I (claims 1-28), and set II (claims 29-34) are not patentably distinct, and therefore the restriction requirement is improper. "Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper". MPEP 806. Inventions I and II are not distinct for the following reasons. The jet engine apparatus of Group I cannot be operated according to a method materially different than that of Group II. The Examiner has not provided an example of another method materially different than that of Group II which can operate the apparatus of Group I. A mere statement of conclusions is inadequate. MPEP

816. However, in compliance with 35 U.S.C. §121, Applicant elects the Group I set (claims 1-28) related to a jet engine.

### **III. SPECIES ELECTION**

In the Office Action, the Examiner stated that the original species election requirement is effectively reactivated, and non-elected claims 2, 3, 6, 8, 10, 11, and 13 revert to their withdrawn status. Applicant respectfully requests consideration of the non-elected claims upon allowance of a generic claim.

### **IV. OBJECTION TO REISSUE APPLICATION**

In the Office Action, the Examiner objected to the reissue application under 37 CFR 1.178(a) for failing to be accompanied by either the original patent or an offer to surrender the original patent. Applicant respectfully requests postponement of surrendering the original until the application is allowed. MPEP 1410 and 1416.

### **V. REJECTION UNDER 35 U.S.C. §251, DEFECTIVE REISSUE DECLARATION**

In the Office Action, the Examiner objected to the reissue application because it fails to identify at least one specific error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP §1414. The Examiner stated that a nominal statement to the effect that the patentee is claiming less than he has a right to claim is not adequate for this purpose. An error in the claims must be identified by reference to specific claim(s) and specific claim language. In addition, the Examiner rejected claims 1, 4, 5, 7, 9, 12 and 14-28 under 35 U.S.C. §251 as being based upon a defective reissue declaration.

In response, Applicant is submitting a supplemental Oath/Declaration. Accordingly, Applicant respectfully requests the objection and the rejection under 35 U.S.C. §251 be withdrawn.

### **VI. REJECTION UNDER 35 U.S.C. §251, RECAPTURE**

In the Office Action, the Examiner rejected claims 1, 4, 5, 7, 9, 12, and 20-27 under 35 U.S.C. §251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

In particular, the Examiner stated that the claimed invention allowed in the '622 Application comprises a jet engine with two adjacent exhaust streams distinguished by the

fact that one was supersonic and the other was subsonic. In response, Applicant has amended claim 1. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §251, recapture be withdrawn.

#### **VII. CLAIM REJECTIONS UNDER 35 U.S.C. §112**

In the Office Action, the Examiner rejected claims 20 and 21 under 35 U.S.C. §112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner stated that the control feature is applied to the second stream rather than the first stream as suggested by the claims. The Examiner further stated that “there is in fact nothing in the claims or the disclosure that appears actually capable of providing direct control of eddy velocity in either stream”. Applicant respectfully traverses the rejections for the following reasons.

An Applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961,1966 (Fed. Circ. 1997). MPEP 2163. In the present application, the disclosure explicitly describes the control of the eddy velocity as shown in equations (1) through (8). See column 6, lines 1-67; column 7, lines 1-31. The disclosure also describes specific embodiments on how to achieve this. See column 8, lines 33-47; column 8, lines 54-67; column 9, lines 1-27.

Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §112 be withdrawn.

#### **VIII. CLAIM REJECTIONS UNDER 35 U.S.C. §102(b)**

In the Office Action, the Examiner rejected claims 1, 4, 5, 7, 9, 12, 20, 21, and 25-27 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 2,672,726 issued to Wolf et al. (“Wolf”) or U.S. Patent No. 2,798,360 issued to Hazen et al. (“Hazen”). In particular, the Examiner stated that the “claim language referring to the temperature/velocity control mechanism as being ‘to control Mach waves...’ merely sets forth an intended use or desired result.” Applicant respectfully disagrees. First, a comment based on the claim language is not appropriate in a rejection under 35 U.S.C. §102(b). It should be discussed under 35 U.S.C. §112. Second, the Examiner has not proved or cited any authority stating that

language of "intended use or desired result" would render a claim invalid. Third, the limitation "to control Mach waves formation" is not an intended use or a desired result. Rather it is a functional limitation and is permissible. MPEP 2173.05(g).

However, claim 1 has been amended to provide further specificity to the claim language. Accordingly, Applicant respectfully requests the rejection under 35 U.S.C. §102(b) be withdrawn.

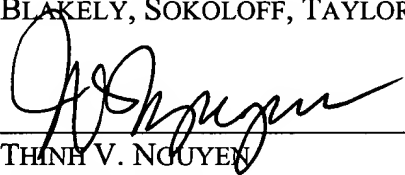
CONCLUSION

In view of the amendments and remarks made above, it is respectfully submitted that the pending claims are in condition for allowance, and such action is respectfully solicited.

Respectfully submitted,

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CERTIFICATE OF MAILING

*I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on: January 8, 2003 .*

  
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